UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
3628	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 March 2009</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-42,45-58,61-74,77-89 and 92-96</u> is/are pending in the application.
   4a) Of the above claim(s) <u>1-32, 48, 64, 80, 95 and 96</u> is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-42,45-58,61-74,77-89 and 92-96</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/24/2009 has been entered.

Response to Amendment

Amendment received on 03/24/2009 is acknowledged and entered. Claims 1-32, 48, 64, 80, 95 and 96 have been previously withdrawn from consideration. Claims 43-44, 59-60, 75-76, 90-91 have been canceled. Claims 33, 49, 65, 81 have been amended. Currently, claims 1-42, 45-58, 61-74, 77-89, 92-96 are pending in the application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 33-42, 45-47, 65-74, 77-79, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 33-42, 45-47 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*,

409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes should positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus which accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Claims 33-42, 45-47 identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and accordingly are directed to non-statutory subject matter. As per claims 65-74, 77-79, the claim recite a system in means plus function format which could be understood (based on Applicant's specification) as merely computer executable instructions or code per se, which is not statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1.

Claims 33-42, 45-47, 49-58, 61-63, 65-74, 77-79, 81-89, and 92-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara (US 6,233,568 B1) in view of Manduley et al. (US 5,324,893) further in view of Sansone et al. (US 5,019,991) and further in view of Official Notice.

Kara teaches a method, system and computer-readable medium having computer-readable instructions embedded therein for causing a computer to implement said method for receiving payment for postage for a parcel, comprising:

Claims 33, 49, 65, and 81,

receiving from the customer mailing information for a parcel, the mailing information comprising customer-determined attributes of the parcel (Figs. 7-8A; C. 5, L. 60-67; C. 19, L. 55-65; C. 20, L. 62-67);

calculating a first postage value based on the customer-determined attributes (C. 5, L. 43-52; C. 9, L. 36-42);

transmitting data to the customer to permit printing by the customer of a mailing label for the parcel, the mailing label including an indication of the first postage value (P. 6, L. 1-2; C. 20, L. 1-3);

charging a customer account for the first postage value (C. 6, L. 12-21; C. 22, L. 13-19).

Kara does not specifically teach:

that said attributes comprising at least one of height, length, and thickness of the parcel;

determining attributes of the parcel by the delivery system operator;

calculating a second postage value for the parcel based on the operator-determined attributes; and

transmitting a postage payment adjustment amount to the customer account based on a comparison between the first and second postage values.

Manduley et al. teaches a method and system for verifying postage amount, wherein the actual/proper postage due is compared with the amount submitted by a sender (C. 4, L. 58-60). In operation, the geometrical dimensions of the individual mailpieces are obtained and compared with operator inputted dimensions of a sample of the mailpieces batch, the proper postage rate is computed and compared to the amount submitted by a sender, and a postage payment adjustment amount is transmitted to the customer account based on a comparison between the first and second postage values (C. 5, L. 53 - C. 6, L. 8; C. 6, L. 23-35), wherein necessary additional postage levied in the event the discrepancy exceeds a specified value (C. 6,

L. 33-34) indicates "requesting additional payment when the second postage value is greater than the first postage value".

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kara to include transmitting a postage payment adjustment amount to the customer account based on a comparison between the first and second postage values, as disclosed in Manduley et al., because it would advantageously allow to avoid returning short paid mail to the sender where more postage is required.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kara and Manduley to include transmitting a postage payment adjustment amount to the customer account based on a comparison between the first and second postage values, as disclosed in Manduley et al., because it would advantageously allow to avoid returning short paid mail to the sender where more postage is required.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kara and Manduley to include that said attributes comprising at least one of height, length, and thickness of the parcel, because it would advantageously allow to facilitate processing batches of mailpieces with enhanced accuracy by relying on important attribute of the sample taken (Manduley et al., C. 5, L. 34-52). And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kara and Manduley to include determining attributes of the parcel by the delivery system operator; calculating a second postage value for the parcel based on the operator-determined attributes; and transmitting a postage payment adjustment amount to the customer account based on a comparison between the first and second postage values, as disclosed in Manduley et al., because it would advantageously allow to avoid returning short paid mail to the sender where more postage is required.

Sansone et al. (Sansone) teaches a method and system for verifying postage amount, wherein the actual/proper postage due is compared with the amount submitted by a sender, and if the postage amount exceeds the determined value, the sender

account is debited to account for the discrepancy (C. 4, L. 5-15; C. 5, L. 15-22). Furthermore, Official Notice is taken that it is old and well known to credit customer's account in the event of overpayment. Therefore, It would have been prima face obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Kara and Manduley to include debiting customer account if the postage amount is less than the determined value, as disclosed in Sansone, and crediting customer account if the postage amount required exceeds the determined value, because it would advantageously allow to avoid returning mail to the customer when the customer's account has to be adjusted, as specifically stated in Sansone (C. 2, L. 33-35).

Claims 34, 35, 50, 51, 66, 67, 82 and 83. Kara discloses that the mailing information is received from the customer over a network (Fig. 1A).

Claims 34, 35, 50, 51, 66, 67, 82 and 83. Ramsden discloses that the mailing information is received from the customer over a network (the Internet) (Fig. 1A).

Claims 36, 52, 68, 84. Kara discloses that the customer-determined attributes include at least one of height, length, weight, thickness, and weight of the parcel (Fig. 8).

Claims 37, 53, 69, and 85. Kara discloses that the mailing information comprises at least one of return address information, destination address information, and payment information (Fig. 8).

Claims 38, 39, 54, 70, 71 and 86. Kara discloses that the mailing information comprises at least one of return address information, destination address information, and payment information (Fig. 8).

Claim 40, 56, 72, 87. Kara discloses that the customer account is a credit card account (C. 31, L. 44).

Claims 41, 57, 73, and 88. Kara discloses that the mailing label further comprises a unique identification code for the parcel (Fig. 3B; C. 9, L. 40-43).

Claims 42, 45-47, 55, 58, 61-63, 74, 77-79, 89, 92-94, same reasoning as applied to independent claims.

2.

Claims 33-42, 45-47, 49-58, 61-63, 65-74, 77-79, 81-89, and 92-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramsden et al. (US 6,105,014) in view of Manduley et al. (US 5,324,893) further in view of Sansone et al. (US 5,019,991) and further in view of Official Notice.

Ramsden et al. (Ramsden) teaches a method, system and computer-readable medium having computer-readable instructions embedded therein for causing a computer to implement said method for receiving payment for postage for a parcel, comprising:

Claims 33, 49, 65, and 81,
receiving from the customer mailing information for a parcel, the mailing information comprising customer-determined attributes of the parcel, said attributes comprising at least one of height, length, and thickness of the parcel (manual input by the customer including the dimensions of the parcel) (C. 20, L. 18-19);
calculating a first postage value based on the customer-determined attributes (C. 20, L. 65-67);

transmitting data to the customer to permit printing by the customer of a mailing label for the parcel, the mailing label including an indication of the first postage value (C. 21, L. 15-35);

charging a customer account for the first postage value (C. 19, L. 17-38; C. 22, L. 43-62);

determining attributes of the parcel comprising at least one of height, length, and thickness of the parcel by the delivery system operator (service personnel C. 22, L. 24-27) after the parcel is received by the delivery system operator for delivery (C. 21, L. 39-54).

Ramsden does not specifically teach: transmitting a postage payment adjustment amount to the customer account based on a comparison between the first and second postage values, wherein transmitting the postage payment adjustment amount further comprises:

requesting additional payment when the second postage value is greater than the first postage value, and generating a credit when the second postage value is less than the first postage value.

Manduley et al. teaches a method and system for verifying postage amount, wherein the actual/proper postage due is compared with the amount submitted by a sender (C. 4, L. 58-60). In operation, the geometrical dimensions of the individual mailpieces are obtained and compared with operator inputted dimensions of a sample of the mailpieces batch, the proper postage rate is computed and compared to the amount submitted by a sender, and a postage payment adjustment amount is transmitted to the customer account based on a comparison between the first and second postage values (C. 5, L. 53 - C. 6, L. 8; C. 6, L. 23-35), wherein necessary additional postage levied in the event the discrepancy exceeds a specified value (C. 6, L. 33-34) indicates "requesting additional payment when the second postage value is greater than the first postage value".

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ramsden to include transmitting a postage payment adjustment amount to the customer account based on a comparison between the first

and second postage values, as disclosed in Manduley et al., because it would advantageously allow to avoid returning short paid mail to the sender where more postage is required.

Sansone et al. (Sansone) teaches a method and system for verifying postage amount, wherein the actual/proper postage due is compared with the amount submitted by a sender, and if the postage amount exceeds the determined value, the sender account is debited to account for the discrepancy (C. 4, L. 5-15; C. 5, L. 15-22). Furthermore, Official Notice is taken that it is old and well known to credit customer's account in the event of overpayment. Therefore, It would have been prima face obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Ramsden and Manduley to include debiting customer account if the postage amount is less than the determined value, as disclosed in Sansone, and crediting customer account if the postage amount required exceeds the determined value, because it would advantageously allow to avoid returning mail to the customer when the customer's account has to be adjusted, as specifically stated in Sansone (C. 2, L. 33-35).

Claims 34, 50, 66, 82 Ramsden discloses said computer-implemented method and system wherein the mailing information is received from the customer via computer, thereby suggesting a network (Figs. 11, 12, 15A-15D).

Claims 35, 51, 67, and 83. Ramsden discloses all the limitations of claims 35, 51, 67 and 83, including receiving the mailing information from the customer via the network, except that said information is received over the Internet. Official Notice is taken that the use of the Internet for receiving information is old and well known. The motivation to modify Ramsden to include the use of the Internet for receiving information would be to advantageously arrange the system in a distributed fashion, and presenting at the customer display guiding information which can be controlled from the central location, and promotional information which can be obtained from various remote sources (Ramsden, C. 19, L. 5-15)

Claims 36, 52, 68, 84. Ramsden discloses that the customer-determined attributes include weight of the parcel (Fig. 8).

Claims 37, 53, 69, and 85. Ramsden discloses that the mailing information comprises at least one of return address information, destination address information, and payment information.

Claims 38, 39, 54, 70, 71 and 86. Ramsden discloses that the mailing information comprises at least one of return address information, destination address information, and payment information.

Claim 40, 56, 72, 87. Ramsden discloses that the customer account is a credit card account (C. 15, L. 37; C. 19, L. 17-21).

Claims 41, 57, 73, and 88. Ramsden discloses that the mailing label further comprises a unique identification code for the parcel (bar-code) (C. 21, L. 22-29).

Claims 42, 45-47, 55, 58, 61-63, 74, 77-79, 89, 92-94, same reasoning as applied to independent claims.

Response to Arguments

Applicant's arguments with respect to claims 33-47, 49-63, 65-79 and 81-94 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.   Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Igor N. Borissov/
Primary Examiner, Art Unit 3628
04/25/2009